APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/652,109	08/29/2003	David L. Kaminsky	RSW9-2003-0112US1 (107)	9838

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ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>14 March 2007</u>.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-13</u> is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-13</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>29 August 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>N/A</u>.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

BACKGROUND

1.　This FINAL Office Action is responsive to the following communications: Amendment filed on 3/14/07 .

2.　Claims 1–13 are pending in this case. Claims: 1, 6, and 10 and are in independent form.

3.　Applicants Arguments concerning the Examiner's rejections of claims 1–5, made under 35 U.S.C. §101 in the previous Office Action (dated 12/14/2006) have been fully considered but are not persuasive for the reasons set forth hereunder.

4.　Applicants Arguments concerning the Examiner's rejections of claims 1–5, made under 35 U.S.C. §102 35 U.S.C. 102(e) in view of *Underwood* (US Pat. No. 6,601,233 B1) in the previous Office Action (dated 12/14/2006) have been fully considered but are not persuasive for the reasons set forth hereunder.

CLAIM REJECTIONS - 35 U.S.C. §101

5.　35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6.   **Claims 1-5** are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter, and further raises questions as to whether the claims are directed to an abstract idea. <u>As an initial matter, claims 1–5 lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 U.S.C. 101</u>.

They are clearly not a series of steps or acts, to be a process, nor are they a combination of chemical compounds to be a composition of matter.

More specifically, Claims 1-5 are directed to computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of software programs because the "System" limitation recited, in claims 1-5, is not limited to a hardware system. In other words, even though it is true that any structurally limiting terminology in the preamble must be treated as a claim limitation[1] – the "System" limitation recited in claims 1-5, in light of the specification, is not limited to hardware and would be reasonably interpreted by one of ordinary skill in the art to be a software-only system, exclusive of those that are "computer-readable" in light of, *inter alia*, the teaching in second paragraph of page 11 of Applicants' Specification "The present invention can be realized in hardware, <u>software, or</u> a combination of hardware and software." (emphasis added).

Applicant is reminded that during patent examination, the claims <u>must be</u> interpreted as broadly as their terms reasonably allow[2]. In other words, the pending claims must be "given their broadest reasonable interpretation consistent with the specification."[3] Additionally, the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.[4]

Accordingly, applicants software-only "system" does not define any structural and functional interrelationship between the software and any elements of a computer which permit the software system's functionality to be realized. Therefore, claims 1-5, being directed toward computer listings *per se*, fail to fall within a statutory category.

<u>CLAIM REJECTIONS - 35 U.S.C. §102</u>

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

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[1] *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989).
[2] *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004)
[3] *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005)
[4] *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999)

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent,
published under section 122(b), by another filed in the United
States before the invention by the applicant for patent or (2) a
patent granted on an application for patent by another filed in
the United States before the invention by the applicant for
patent, except that an international application filed under the
treaty defined in section 351(a) shall have the effects for
purposes of this subsection of an application filed in the United
States only if the international application designated the United
States and was published under Article 21(2) of such treaty in the
English language.

8.   **Claims 1-13** are rejected under 35 U.S.C. 102(e) as being anticipated

by *Underwood* (US Pat. No. 6,601,233 B1).

As to independent **claim 1**, *Underwood* teaches a system for autonomically

configuring a user interface ("...developing computer software using...a collection of

largely autonomous components, called objects..." col. 11, lines 44-55) comprising: at

least one widget programmed to be disposed in the user interface ("User Interface

{UI} components. Custom 'widgets' {e.g., real-time stock tickers, animated icons,

etc.}..." col. 16, lines 39-42), said at least one widget comprising a dynamically

configurable presentation field (e.g. "The AFViewDynamicBOMapping component

defines the mapping between a dynamically created user interface field and the

business component instances containing the value to display." col. 38, lines 62-65;

see also "AFViewDynamicBOMapping" col. 31, lines 30-40); and, a policy comprising

a plurality of business rules ("Application Logic is the expression of business rules

and procedures [and the] Application Logic includes the control structure that

specifies the flow for processing for business events and user requests." col. 125,

lines 39-43; *see also* "...business rules..." col. 316, lines 24-26) for configuring said at

least one widget in the user interface based upon a context provided by said at least

one widget ("AddToUIContext [:] Add a User Interface component to the UI context

of the activity." col. 32, lines 27-28); and, a rules engine configured to process said

business rules ("The control logic 14602" col. 316, lines 24-31).

As to dependent **claim 2**, *Underwood* further teaches at least one widget

comprises a widget configured to be disposed in a markup language document ("A

preferred embodiment of the invention utilizes HyperText Markup Language

(HTML) to implement documents on the Internet together with a general-purpose

secure communication protocol for a transport medium between the client and a

company. " col. 15, line 61 -to- col. 16, line 8; *see also* e.g."...form element widgets to

build the necessary HTML code..." col. 64, lines 30-37).

As to dependent **claim 3**, *Underwood* further teaches that that business rules

specify at least one suggested option to be presented to an end user through said at

least one widget (e.g. "...get the Customer Object from the Activity Context and add

the default values..." col. 282, lines 35-36).

As to dependent **claim 4**, *Underwood* teaches business rules specifying at

least one option which is not to be presented to an end user through said at least

one widget ("activity components to which the current page, previous page record,

and information are provided may be selectively determined " col. 57, lines 10-13;

see also e.g. "...embed hidden data within forms..." col. 302, lines 40-43; *see also* e.g.

"ability to hide different implementations of a function behind the same name " col. 12, lines 42-44).

As to dependent **claim 5**, *Underwood* further teaches the business rules specifying rules for validating input provided through the presentation field ("...utilize externally stored parameters and validation rules. For example, an application may be designed to retrieve the tax rate for the State of Illinois. When the user enters "Illinois" on the screen, the application first validates the user's entry by checking for its existence on the "State Tax Table", and then retrieves the tax rate for Illinois. " col. 119, lines 3-12).

As to independent **claim 6**, *Underwood* teaches a method for autonomically configuring a user interface widget ("[d]eveloping [a] collection of [a]utonomous components, called objects..." col. 11, lines 44-55; *see also* "User Interface {UI} components. Custom 'widgets' {e.g., real-time stock tickers, animated icons, etc.}..." col. 16, lines 39-42), the method comprising the steps of: evaluating business rules for configuring the user interface widget (e.g. via "[t]he control logic 14602" col. 316, lines 24-31) according to context information for the user interface widget ("AddToUIContext [:] Add a User Interface component to the UI <u>context of the activity.</u>" col. 32, lines 27-28)(emphasis added); and, configuring the user interface widget with options permitted by said evaluation ("...information [p]rovided may be selectively determined..." col. 57, lines 10-13).

As to dependent **claim 7**, *Underwood* further teaches the configuring step comprising the step of suggesting at least one option to be presented to an end user through said user interface widget (e.g. "...get the Customer Object from the Activity Context and add the default values..." col. 282, lines 35-36).

As to dependent **claim 8**, *Underwood* further teaches the configuring step comprising the step of filtering at least one option from being presented to an end user through said user interface widget ("activity components to which the current page, previous page record, and information are provided may be selectively determined " col. 57, lines 10-13; *see also* e.g. "...embed hidden data within forms..." col. 302, lines 40-43; *see also* e.g. "ability to hide different implementations of a function behind the same name " col. 12, lines 42-44).

As to dependent **claim 9**, *Underwood* further teaches the configuring step comprising the step of validating input provided through a presentation field in said user interface ("...utilize externally stored parameters and validation rules. For example, an application may be designed to retrieve the tax rate for the State of Illinois. When the user enters "Illinois" on the screen, the application first validates the user's entry by checking for its existence on the "State Tax Table", and then retrieves the tax rate for Illinois. " col. 119, lines 3-12).

As to independent **claim 10,** this claim differs from claim 6 only in that it is directed to a product .defined by the process of claim 6. Furthermore, *Underwood* teaches that the autonomic configuring of the user interface widget can be

accomplished by "A computer program embodied on a computer readable medium" (col. 326, lines 41-42). Therefore, claim 10 is rejected for the same reasons set forth in the treatment of claim 6, above.

As to dependent **claims 11-13**, these claims differ from claims 7-9, respectively, only in they are directed to products defined by the processes of claims 7-9, respectively. Since *Underwood* teaches the autonomic configuring of the user interface widgets by "A computer program embodied on a computer readable medium" (col. 326, lines 41-42) - these claims are rejected for the same reasons set forth in the treatment of claims 7-9, respectively.

RESPONSE TO ARGUMENTS

9.   **Applicant arguments, see p. 2–3, filed 3/14/2007, with respect to the Rejections cited by the Examiner in the previous Office Action (dated 12/14/2006), of Claims 1–5 under 35 USC §101 with regard to statutory subject matter have been fully considered but are not persuasive.**

Appearing on pages 2–3, under <u>Remarks</u>, the Applicant asserts:

> Applicants are unaware of any "software-only-system" that is capable of being "configured to process said business rules." Software alone is incapable of doing anything because it is disconnected from hardware. Applicants also note that the Examiner's assertion that a system limitation does not necessarily mean a hardware system is a conclusory statement that lacks both factual and legal support.

Applicant is directed to read the last two paragraphs of their specification which elucidate to the contrary:

>...The present invention can also be embedded <u>in a computer program</u>... being loaded and executed....Computer program or application in the present context means any expression, in any language, code or notation, of a set of instructions intended to cause a system having an information processing capability to perform a particular function either directly or after either or both of the following a) conversion to another language, code or notation; b) reproduction in a different material form.

Appearing on pages 2–3, under <u>Remarks</u>, the Applicant relies on the premise that software is incapable of being programmed and, therefore, concludes that widget cannot be software alone:

>In this regard, Applicants note that claim 1 recites "at least one widget programmed to be ...." Software alone is incapable of being "programmed." Instead, software alone is the program. Thus, the claimed at least one widget cannot be software alone, as alleged by the Examiner.

Applicants' argument is based on untenable grounds, especially in view of the conspicuous teaching in the first paragraph on page 4 of their Specification: "Notably, the widget can be a widget configured to be <u>disposed</u> in a markup language document." Notwithstanding Applicants' argument that the claimed at least one widget cannot be software alone, how exactly does the 'system' become "<u>Notably</u>...disposed in a markup language document?" (emphasis added).

The Examiner is not persuaded by the applicants attempt to control interpretation of the claims through the deliberate contradiction of express teachings of the Specification. Applicant is reminded that the pending claims must be "given their broadest reasonable interpretation <u>consistent with the</u>

specification."⁵ and that the broadest reasonable interpretation of the claims <u>must</u>

<u>also</u> be consistent with the interpretation that those skilled in the art would reach.⁶

10.   Applicant arguments, see p. 2–3, filed 3/14/2007, with respect to

the Rejections cited by the Examiner in the previous Office Action (dated

12/14/2006), of Claims 1–5 under 35 USC §102(e) with regard to anticipation

have been fully considered but are not persuasive.

Generally speaking, *Underwood* comprehensively discloses models of real-

world concepts in the business domain using partitioned business components. As

independent pieces of software, the components are the physical building blocks

used in the assembly of applications through well-defined interfaces.

With respect to applicant's arguments:

Appearing on pages 3–5, under Remarks, the Applicant asserts:

> ...it appears that the Examiner is manufacturing a single specific
> teaching in Underwood so as to identically disclose the claimed
> limitation by combining multiple completely <u>unrelated</u> teachings from
> Underwood.

Applicant's arguments fail specifically point out or focus on how the language

of the claims patentably distinguishes them from the cited reference. More

specifically, Applicant has not demonstrated why the teachings are "completely

unrelated." It appears that the applicant is proposing that the teachings are not

related to each other because they do not materialize in proximity to other

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⁵ *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005).

teachings within the <u>same reference</u>. Applicant has only considered the locations

cited by the examiner *in vacuum*, that is, without the context and defined meanings

of the cited teachings by other portions of the <u>same reference</u>. Applicant should note

that "The use of patents as references is not limited to what the patentees describe

as their own inventions or to the problems with which they are concerned. They are

part of the literature of the art, relevant for all they contain."[7] A reference may be

relied upon for all that it would have reasonably suggested to one having ordinary

skill the art, including non–preferred embodiments.[8]

   Appearing on pages 3–5, under <u>Remarks</u>, the Applicant asserts:

> Upon reviewing the passages cited by the Examiner, Applicants note
> that the Examiner's citations to column 125 and column 316 are
> <u>completely silent </u>with regard to "configuring said at least one widget
> in the user interface," as claimed.

In response, the Examiner directs applicant's attention to the following teaching in

Underwood:

> This portion of the present description details the ReTA User Interface
> (UI) framework design from the perspective 60 of the application
> developer. The role of this framework is to provide services that
> generate the HTML code for UI widgets and attach Javascript actions
> to UI widgets. (Col. 62, lines 58–63).

   Appearing on pages 3–5, under <u>Remarks</u>, the Applicant asserts:

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[6] *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).
[7] *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).
[8] *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989)

Moreover, the Examiner's citation to column 32 is <u>completely silent</u> as to the application logic/business rules described in column 125 and the control logic described in column 316.

In response, the Examiner directs applicant's attention to following teaching to clarify the teachings in column 32: "The views map the UI widgets to attributes of business objects" (col. 280, lines 10–11).

CONCLUSION

11.   All prior art made of record in this Office Action or as cited on form PTO-892 notwithstanding being relied upon, is considered pertinent to Applicants' disclosure. Therefore, Applicant is required under 37 CFR §1.111(c) to consider these references fully when responding to this Office Action.

12.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
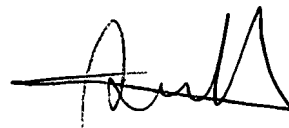
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
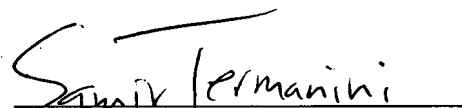
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Samir Termanini at telephone number is (571) 270-1047. The Examiner can normally be reached from 9 A.M. to 6 P.M., Monday through Friday.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Stephen S. Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

STEPHEN HONG
PRIMARY PATENT EXAMINER

Samir Termanini
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Art Unit 2178